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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,444	06/06/2001	Bruce R. Baird	15184.2	5041

7590 08/27/2004

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EXAMINER

WOO, ISAAC M

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,444

Applicant(s)

BAIRD ET AL.

Examiner

Isaac M Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10, 12-15 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 16-17 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02 July 2004, has been entered.

2. Claims 1, 12-16, 18-20 are currently amended. Claim 11 is canceled. Claims 20-21 are newly added. And claims 1-10, and 12-21 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borovoy et al (U.S. Patent No. 5,873,107, hereinafter, "Borovoy") in view of Dutta et al (U.S. Patent No. 6,636,854, hereinafter, "Dutta").

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With respect to claim 16, Fields discloses, within an application, (text authoring system, col. 2, lines 26-32), previewing data that has not been selected by a user within at least one application, see (fig. 2, col. 26-39, text data is displayed on 201, window user interface, fig. 1, the text data on window user interface not was not selected yet); selecting a portion of the previewed data as search terms (205, 207, fig. 2) without user input, see (col. 2, lines 26-40, col. 3, lines 40-48, system automatically selects keywords means without user input); performing a search without user input, wherein the search is based on the portion of the previewed data (extracted keywords), see (fig. 2, col. 2, lines 26-40, col. 3, lines 40-67 to col. 4, lines 1-30, extracted keywords are used as new auto-query input); and wherein the search results are readily available to a user, see (209, fig. 2, col. 3, 48-67 to col. 4, lines 1-30, search results are displayed on 209, fig. 2). Borovoy does not explicitly disclose caching search results from the search. However, Dutta discloses, "results of the search should be received within a relatively short amount of time. The search results are stored or cached as they are received", see (col. 7, lines 3-15). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include caching search results from the search in the system of Borovoy. Because cache in one of a storage medium and caching is storing the data in the storage medium. Stored (cached) data is used for computer retrieval system.

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With respect to claim 17, Borovoy discloses the computer instructions, see (col. 2, lines 26-40, computer system contains computer instructions).

With respect to claim 21, Borovoy discloses that application is selected from the group of: word processor, spreadsheet, database, image processor, web browsers, text recognition, email client, and operating system, see (fig. 2, col. 3, 25-67).

Allowable Subject Matter

5. Claims 1-10, 12-15 and 18-20 are allowed over prior art. The following is a statement of reasons for the indication of allowable subject matter:

Due to claimed features in the amended claims 1, 14 and 18-19, the claims 1-10, 12-15 and 18-20 are allowed.

For the claims 1, 14 and 18-19, the prior art teaches (Bennett, et al, U.S. Patent No. 5,950,194) system and method for selecting one or more search terms within a first application at a computer, activating the one or more search terms within the first application, performing a search based on the one or more search terms with a second application at the computer such that the computer remains in a context of the first application and does not display the second application to a user.

The prior art does not teach combination steps for executing a search term within an application for returning search results to the first application,

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wherein returning search results generated by the second application to the first application comprises of: copying at least a portion of the search results into the first application, pasting at least a portion of the search results into the first application, deleting a portion of the search results, saving at least a portion of the search results, and displaying search results when a mouse arrow is moved over the selected search data in the first application.

Claims 2-10, 12-13, 15 and 20, dependent claims, being definite, further limiting, and fully enabled by the specification, are also allowed.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
August 9, 2004


SHAHID ALAM
PRIMARY EXAMINER